

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Shimizu, Toshiaki EXAMINER: Capron, Aaron J.
SERIAL NO.: 09/966,468 GROUP ART UNIT: 3714
FILED: September 28, 2001 ATTY DOCK. NO.: 60,518-004
FOR: **GAMING MACHINE HAVING DYNAMIC BONUS FEATURE**

APPEAL BRIEF

Board of Patent Appeals and Interferences
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Dear Sir or Madam:

Applicant submits the following Appeal Brief in response to the Final Rejection set forth in the Final Office Action, dated June 8, 2004, Paper No. 20040602. A check in the amount of \$340.00 is attached to cover the required fee for submitting this Appeal Brief. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 08-2789.

(1) Real Party in Interest

The real party in interest is Konami Gaming, Inc., assignee of the patent application in issue, as evidenced by an assignment recorded at Reel/Frame 013014/0869.

(2) Related Appeals and Interferences

NONE

(3) Status of Claims

Claims 1-8, 12-22, and 24-30 are pending in the application. Claims 1, 12, 20, 26, and 30 are independent. Claims 9-11 and 23 have been canceled. Claims 1-8, 12-22, and 24-30 stand rejected. Claims 1-8, 12-22, and 24-30 are on appeal.

(4) Status of Amendments

All amendments have been entered and are reflected in the claims in the Claims Appendix.

(5) Summary of Claimed Subject Matter

Claims 1-8, 12-22, and 24-30 are on appeal. Of those, claims 1, 12, 20, 26, and 30 are independent. The present invention provides a gaming machine 10 having a dynamic bonus feature (independent claims 1, 26, 30), a method of playing the gaming machine 10 (independent claim 12), and a readable recording medium storing an executable control program for carrying out the method (independent claim 20).

Referring to Figures 1 and 2, the gaming machine 10 comprises a controller 22 and a display processor 18. During play, the controller 22 sends a signal to the display processor 18 to display a first plurality of game elements in a grid 14 of cells 16 connected to the display processor 18. The display processor 18 randomly displays the first plurality of game elements 20 in a normal random display such that one game element 20 is displayed in each of the cells 16. Referring to Figure 3, the display processor 18 preferably displays the first plurality of game elements in a plurality of reels 24.

The controller 22 initiates a bonus random display of a second plurality of game elements 20 in response to a triggering combination 30 of the first plurality of game elements 20 in the normal random display. The triggering combination 30 includes a set of predetermined symbols being displayed in the cells 16. In one embodiment, shown in Figure 3, the triggering combination is at least 3 apples appearing in a wagered payline. (Refer to paragraph 0029 of the specification). When the bonus random display is initiated, the display processor replaces the first plurality of game elements 20 present in the cells 16 with the second plurality of game elements 20. In other words, the reels 24 spin and substitute the first plurality of game elements 20 in the cells 16 with the second plurality of game elements 20.

During the bonus random display, the controller 22 designates at least one cell 16 as a wild cell 34. Once the controller 22 designates the wild cell 34, a wild character, such

as a wild bee, moves along the grid 14 of cells 16, while the reels 24 are spinning, i.e., while the first plurality of game elements 20 are being replaced with the second plurality of game elements 20, and designates the wild cell 34 independent of any game element 20 that later appears in the wild cell 34. (Refer to paragraph 0031 of the specification). This designation may come in the form of the wild bee touching one of the cells 16, placing a card over one of the cells 16, and the like. (Refer to paragraph 0032 of the specification). By having the wild character move along the grid 14 of cells 16 and designate the wild cell 34 while the reels are spinning, a player's enthusiasm for the game is heightened, as he or she recognizes the increase in the probability of a winning outcome due to the presence of the wild cell 34.

After the reels 24 cease to spin, if any winning combination is formed with or without the wild cell 34, the player is awarded a predetermined value.

(6) Grounds of Rejection to be Reviewed on Appeal

A. Claims 1, 8, 12, 19-20, and 24-30

Claims 1, 8, 12, 19-20 and 24-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Olive (U.S. Pat. No. 6,634,941).

B. Claims 2, 4-7, 13, 15-18, and 21

Claims 2, 4-7, 13, 15-18, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Olive in view of Jaffe (U.S. Pat. No. 6,517,432).

C. Claims 3, 14, and 22

Claims 3, 14, and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Olive in view of Jaffe.

(7) Argument

A. Claims 1, 8, 12, 19-20, and 24-30

The rejection to claims 1, 8, 12, 19-20 and 24-30 relies on common knowledge and Olive '941, i.e., the combination of Olive with the knowledge generally available to one of

ordinary skill in the art. This combination does not comport with the mandates of the MPEP for establishing a *prima facie* case of obviousness and is based on hindsight in view of the Applicant's disclosure. MPEP §§2142 and 2143.03 set forth the requirements for establishing the *prima facie* case of obviousness:

2142 Legal Concept of *Prima Facie* Obviousness

...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness...

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143-§2143.03 for decisions pertinent to each of these criteria. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

2143.03 All Claim Limitations Must Be Taught or Suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Independent claims 1, 12, 20, 26, and 30 each require activating a bonus character to move along a grid 14 of cells 16 and designate at least one of the cells 16 in the grid 14 as a wild cell 34 independent of a game element 20 in the wild cell 34 in response to initiating a bonus random display. Claims 1, 12, 20, 26, and 30 also require the bonus character to designate the wild cell 34 while the first plurality of game elements 20 are being replaced by the second plurality of game elements 20, i.e., while reels 24 are spinning. In the disclosed embodiment, this designation may come in the form of a wild bee touching one of the cells 16, placing a card over one of the cells 16, and the like. By having the wild character move along the grid 14 of cells 16 and designate the wild cell 34 while the reels are spinning, a player's enthusiasm for the game is heightened, as he or she perceives an increase in the probability of a winning outcome due to the presence of the wild cell 34.

Olive discloses a gaming machine 10 comprising a display 14 having a grid of cells and a controller 44 programmed for initiating a normal random display of game elements in the grid such that one game element is displayed in each of the cells. The controller in Olive is programmed to initiate a bonus round in response to a triggering combination of the game elements in the normal random display. In the bonus round a second plurality of game elements replace the first plurality of game elements in a bonus random display. Once or after being replaced, a bonus character, e.g., a dolphin, selects one of the cells in the bonus random display as being a wild cell. Olive does not suggest activating the bonus character to move along the grid of cells and designate the wild cell while the first plurality of game elements are being replaced by the second plurality of game elements. Olive does not re-spin the reels, while simultaneously moving the bonus character along the grid of cells to designate one of the cells as being wild, as required by claims 1, 12, 20, 26, and 30. Thus, Olive does not teach or suggest every limitation required by claims 1, 12, 20, 26, and 30. Instead, Olive spins the reels once in the normal random display and evaluates the outcome, then spins the reels again in the bonus random display and evaluates the outcome, then without spinning the reels again, activates the bonus character to select the wild cell. In this case, the player would only become excited about the bonus character if, after looking at the bonus random display, there appears a cell that, if wild, would result in a winning outcome. If

the player views the bonus random display and notices that there is no possible winning outcome even with the wild cell, then the player would be disinterested in the bonus character. In the present invention, as defined in claims 1, 12, 20, 26, and 30, the wild cell is selected as the reels are spinning. In this case, the player will always be excited about the bonus character and the increased probability for winning that the bonus character provides by designating the wild cell.

The Examiner acknowledges that Olive does not teach activating the bonus character to move along the grid of cells and designate the wild cell while the first plurality of game elements are being replaced by the second plurality of game elements. However, the Examiner suggests that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the game controller to determine the position of the wild cell while the replacement period is occurring since, lacking criticality, it would not alter the game in manner that would distinguish the equivalent functionality of determining the position of the wild cell before or after the replacement period.” (Final Rejection dated June 8, 2004, pages 2-3).

Applicant respectfully submits that the Examiner’s reasons for rejection are misplaced. First, the Applicant does not claim the timing in which the game controller determines the position of the wild cell. Instead, Applicant claims the timing in which the bonus character, e.g., the wild bee, physically designates or selects at least one of the cells as the wild cell.

Second, moving the bonus character along the grid of cells to designate the wild cell while the first plurality of game elements are being replaced by the second plurality of game elements, i.e., while the reels are spinning, does NOT lack criticality. As stated previously, when the bonus character waits until the reels stop spinning (as in Olive) before designating or selecting the wild cell, the player already notes the effect that the bonus character may have on the ultimate outcome of the game. In fact, the bonus character may not have any impact of the outcome, in which case, the player becomes disinterested in the bonus character altogether. In the present invention defined in claims 1, 12, 20, 26, and 30, the player is not only excited that the reels are spinning, but becomes further excited when the bonus character

designates the wild cell while the reels are spinning. In this instance, the player perceives an increased probability of a winning outcome.

Finally, the Examiner has based the rejection of claims 1, 12, 20, 26, and 30 on impermissible hindsight. Presented with only Olive, a person having ordinary skill in the art would not be motivated or equipped to modify Olive to arrive at the present invention as defined in claims 1, 12, 20, 26, and 30. Olive is particularly concerned with using the bonus character, e.g., the dolphin, to designate the wild cell after the bonus random display is completed, to pay an additional prize if the dolphin designates a wild cell that results in a prize winning combination. There is no teaching, suggestion, or motivation in Olive to alter the operation of Olive as suggested by the Examiner, i.e., to have the dolphin designate the wild cell while the reels are spinning in the bonus round. Thus, the Examiner has relied upon impermissible hindsight in suggesting that a person having ordinary skill in the art would find it obvious to move the bonus character along the grid of cells while the reels are spinning, as required by claims 1, 12, 20, 26, and 30. Furthermore, with the present invention, as defined in claims 1, 12, 20, 26, and 30, the player is not only excited about the initiation of the bonus random display in response to the triggering combination, but becomes increasingly excited when the bonus character moves along the grid and designates the wild cell while the reels are spinning.

For these reasons, Applicant respectfully submits that independent claims 1, 12, 20, 26, and 30 are in condition for allowance. Applicant submits that dependent claims 8, 19, 24-25, and 27-29 are also placed in condition for allowance based on their merits and their dependency to claims 1, 12, 20, 26, and 30, and the failure of the references to suggest claims 1, 12, 20, 26, and 30.

B. Claims 2, 4-7, 13, 15-18, and 21

Dependent claims 2, 4-7, 13, 15-18, and 21 are dependent on independent claims 1, 12, and 20, which were rejected based on the impermissible combination of Olive with the knowledge generally available to one having ordinary skill in the art, as set forth in section A. These claims are hereby grouped with the claims of section A to stand or fall with the claims of section A.

C. Claims 3, 14, and 22

The rejection to claims 3, 14, and 22 relies on the combination of Olive with Jaffe. This combination does not comport with the mandates of the MPEP for establishing a *prima facie* case of obviousness. Even if these references could be properly combined, they still do not teach each and every limitation required by claims 3, 14, and 22. Dependent claims 3, 14, and 22 add the limitations of designating multiple wild cells and positioning wild cards over each of the wild cells in response to initiating the bonus random display. The Examiner notes that Olive teaches the placement of a wild card over a wild cell, yet the Examiner acknowledges that Olive does not disclose multiple wild cells. As a result the Examiner adds the teachings of multiple wild cells of Jaffe to Olive. However, neither Jaffe, nor Olive teach, suggest, or disclose multiple wild cells, with multiple wild cards placed over the wild cells, as required by claims 3, 14, and 22.

D. SUMMARY

The rejection to independent claims 1, 12, 20, 26, and 30 based on Olive and the knowledge generally available to a person having ordinary skill in the art is improperly based on Applicant's teachings. Olive does not disclose activating a bonus character to move along a grid of cells and designate a wild cell while a first plurality of game elements are being replaced by a second plurality of game elements and a person having ordinary skill in the art, without more, would not be motivated to modify Olive to achieve the requirements of independent claims 1, 12, 20, 26, and 30. No secondary reference teaches these limitations. Thus, the Examiner has failed to establish the *prima facie* case for obviousness by failing to teach or suggest all of the claimed limitations. Accordingly, the Board is respectfully requested to reverse the rejection of the claims as not fairly based upon the teachings of the references.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

October 29, 2004
Date



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CERTIFICATE OF MAILING

I hereby certify that the attached **APPEAL BRIEF** for application serial number 10/360,428, filed February 6, 2003 is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Board of Patent Appeals and Interferences, P.O. Box 1450, Alexandria, VA 22313-1450, on this **October 29, 2004**.

Christine M. Wolfe
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(8) Claims Appendix

1. A gaming machine comprising:
 - a display having a grid of cells;
 - a first plurality of game elements;
 - a controller for initiating a normal random display of said first plurality of game elements;
 - a display processor for displaying the normal random display of said first plurality of game elements such that one of said first plurality of game elements is displayed in each of said cells;
 - a second plurality of game elements;
 - said controller being programmed for initiating a bonus random display of said second plurality of game elements in response to a triggering combination of said first plurality of game elements in the normal random display;
 - said display processor being programmed for displaying the bonus random display of said second plurality of game elements such that the one of said first plurality of game elements displayed in each of said cells in the normal random display is replaced with one of said second plurality of game elements; and
 - said controller being programmed for activating a bonus character to move along said grid of cells and designate at least one of said cells in said grid as a wild cell independent of a game element in said wild cell in response to initiating the bonus random display and while said first plurality of game elements are being replaced with said second plurality of game elements.
2. A machine as set forth in claim 1 wherein said controller is programmed for designating a plurality of said cells in said grid as wild cells in response to initiating the bonus random display.

3. A machine as set forth in claim 2 wherein said controller is programmed for positioning a wild card over each of said wild cells such that each of said wild cards conceals said game element within said wild cell.

4. A machine as set forth in claim 3 wherein said controller is programmed for repeating the bonus random display a predetermined number of rounds.

5. A machine as set forth in claim 4 wherein said controller is programmed for displaying a winning combination of said game elements having at least one of said wild cells forming said winning combination and awarding a predetermined value for the said winning combination.

6. A machine as set forth in claim 5 further including a coin-bill management device for receiving credit.

7. A machine as set forth in claim 6 further including a coordinate readout device for activating the game and for wagering the credit.

8. A machine as set forth in claim 1 wherein said display includes a plurality of reels and a plurality of rows defining said grid such that the intersection of one of said plurality of reels and one of said plurality of rows defines a cell.

9-11. (Canceled).

12. A method of playing a game, comprising the steps of:
randomly displaying a first plurality of game elements in a grid of cells to produce a normal random display of the first plurality of game elements with one of the first plurality of game elements being displayed in each of the cells;
determining a triggering combination;

comparing the normal random display of the first plurality of game elements with the triggering combination;

initiating a bonus random display of a second plurality of game elements in response to the first plurality of game elements matching the triggering combination;

randomly displaying the second plurality of game elements in the grid of cells to produce the bonus random display of the second plurality of game elements by replacing the one of the first plurality of game elements displayed in each of the cells with one of the second plurality of game elements;

designating at least one of the cells in the grid as a wild cell independent of a game element in the wild cell in response to initiating the bonus random display; and

activating a bonus character to move along the grid of cells and designate the wild cell while the first plurality of game elements are being replaced with the second plurality of game elements.

13. A method as set forth in claim 12 further including the step of designating a plurality of the cells in the grid as wild cells in response to initiating the bonus random display.

14. A method as set forth in claim 13 further including the step of positioning a wild card over each of the wild cells such that the wild card conceals the game element disposed within each of the wild cells.

15. A method as set forth in claim 14 further including the step of repeating the bonus random display for a predetermined number of rounds.

16. A method as set forth in claim 15 further including the step of displaying a winning combination of the game elements having at least one wild cell forming the winning combination and awarding a predetermined value for the winning combination.

17. A method as set forth in claim 16 further including the step of inserting credits into a payment processor and wagering an amount of the credits.

18. A method as set forth in claim 17 further including the step of manipulating an coordinate readout device after wagering the credits for randomly displaying the game elements.

19. A method as set forth in claim 12 further including the step of displaying the grid as a plurality of reels and a plurality of rows such that the cell is the intersection of one of the reels and one of the rows.

20. A readable recording medium storing an executable control program for: randomly displaying a first plurality of game elements in a grid of cells with one of the first plurality of game elements being displayed in each of the cells;

initiating a bonus random display of a second plurality of game elements in response to a triggering combination of the first plurality of game elements in the random display;

displaying the bonus random display by replacing the one of the first plurality of game elements displayed in each of the cells with one of the second plurality of game elements; and

activating a bonus character to move along the grid of cells and designate one of the cells in the grid as a wild cell independent of the game elements in response to initiating the bonus random display and while the first plurality of game elements are being replaced with the second plurality of game elements.

21. A readable recording medium as set forth in claim 20 wherein the control program designates a plurality of the cells in the grid as wild cells in response to initiating the bonus random display.

22. A readable recording medium as set forth in claim 21 wherein the control program positions a wild card over each of the wild cells such that the wild symbol conceals the game element disposed within each of the wild cells.

23. (Canceled)

24. A machine as set forth in claim 1 wherein the one of said first plurality of game elements displayed in one of said cells in the normal random display is the same as the one of said second plurality of game elements displayed in the same cell in the bonus random display.

25. A machine as set forth in claim 1 wherein the one of said first plurality of game elements displayed in one of said cells in the normal random display is different than the one of said second plurality of game elements displayed in the same cell in the bonus random display.

26. A gaming machine comprising:

- a display having a grid of cells;
- a first plurality of game elements;
- a controller for initiating a normal random display of said first plurality of game elements such that one of said first plurality of game elements is displayed in each of said cells;
- a second plurality of game elements;
- said controller being programmed for initiating a bonus random display of said second plurality of game elements in response to a triggering combination of said first plurality of game elements in the normal random display such that the one of said first plurality of game elements displayed in each of said cells in the normal random display is replaced with one of said second plurality of game elements; and
- said controller being programmed for activating a bonus character to move along said grid of cells and designate at least one of said cells in said grid as a wild cell

independent of a game element in said wild cell in response to initiating the bonus random display and while said first plurality of game elements are being replaced with said second plurality of game elements.

27. A machine as set forth in claim 26 wherein the one of said first plurality of game elements displayed in one of said cells in the normal random display is the same as the one of said second plurality of game elements displayed in the same cell in the bonus random display.

28. A machine as set forth in claim 26 wherein the one of said first plurality of game elements displayed in one of said cells in the normal random display is different than the one of said second plurality of game elements displayed in the same cell in the bonus random display.

29. A machine as set forth in claim 26 further including a display processor in operative communication with said controller for displaying the normal random display and the bonus random display.

30. A gaming machine comprising:

- a display having a grid of cells;
- a first plurality of game elements;
- a controller for initiating a normal random display of said first plurality of game elements such that one of said first plurality of game elements is displayed in each of said cells;
- said controller being programmed for displaying a winning combination of said game elements in the normal random display and awarding a predetermined value for the winning combination;
- a second plurality of game elements;
- said controller being programmed for initiating a bonus random display of said second plurality of game elements in response to a triggering combination of said first

plurality of game elements in the normal random display after awarding the predetermined value for the winning combination in the normal random display such that the one of said first plurality of game elements displayed in each of said cells in the normal random display is replaced with one of said second plurality of game elements;

 said controller being programmed for activating a bonus character to move along said grid of cells and designate at least one of said cells in said grid as a wild cell independent of a game element in said wild cell in response to initiating the bonus random display and while said first plurality of game elements are being replaced with said second plurality of game elements; and

 said controller being programmed for displaying a winning combination of said second plurality of game elements having said wild cell forming the winning combination in the bonus random display and awarding a predetermined value for the winning combination in the bonus random display.

(9) Evidence Appendix

NONE

(10) Related Proceedings Appendix

NONE

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